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#4

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/977,221	11/24/97	STRACKE	M 2026-4149US3

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HM11/0928

EXAMINER
LONGTON, E

ART UNIT	PAPER NUMBER
1652	

DATE MAILED: 09/28/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/977,221

Applicant(s)
Stracke et al.

Examiner
Enrique D. Longton

Group Art Unit
1652



☒ Responsive to communication(s) filed on Sep 9, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), ~~or thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 3-6, 9, 11, 12, and 16-19 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 3-6, 9, 11, 12, and 16-19 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1652

DETAILED ACTION

Election/Restriction

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 3-6, 11, 12 and 16-19, drawn to an autotaxin polypeptide, classified in class 530, subclass 350.
- II. Claim 9, drawn to an antibody having binding affinity for autotaxin, classified in class 530, subclass 388.1.

The inventions are distinct, each from the other because of the following reasons:

The protein of group I is related to the antibody of group II by virtue of being the cognate antigen necessary for the production of antibody. Although the protein and antibody are related due to the necessary steric complementarity of the two, they are distinct inventions because the protein can be used in other, materially different processes from the production of antibody such as in a pharmaceutical composition in its own right, or to assay or purify the natural ligand of the protein if it is a receptor. Further, a protein and its cognate antibody are structurally and functionally distinct molecules with different amino acid compositions.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

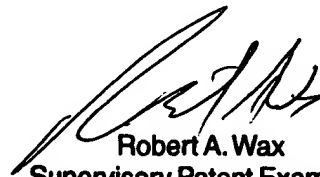
Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

A telephone call was made to Ms. Dorothy Auth on September 18, 1998 to request an oral election to the above restriction requirement, but did not result in an election being made.

Inquiries

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Enrique Longton whose telephone number is (703) 305-4062. The Examiner can normally be reached Monday through Friday from 8:30 a.m. to 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Robert Wax, can be reached on (703) 308-4216. The fax phone number for this Group is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Enrique D. Longton, Ph.D.
September 22, 1998



Robert A. Wax
Supervisory Patent Examiner
Technology Center 1600